REMARKS

I. Claims 9, 12 were amended to correct an error introduced in the Preliminary Amendment and now conforms to the language of the claims in the original PCT publication.

II. In response to point 2, the applicants do not agree that the solution presented in Fig. 1 is part of the prior art. Although this solution was known to the applicants it was not in the public domain and therefore should not constitute prior art for assessing novelty or obviousness of the present invention and should not marked as such in the figure. This is further discussed in point IV below.

Further, in response to point 2 the applicants have corrected the description by adding headings.

III. In response to point 4, U.S. Patent Application Publication No. 2003/0002104 to Caroli discloses an add/drop node which can be controlled from a remote location and the disclosed solution is focused on channel assignment and collision avoidance. The present invention is focused on improving optical signal-to-noise ratio, OSNR, in the add path as it is stated on page 3, lines 7-12 of the PCT publication.

Applicants do not agree with the Examiner that the present invention is anticipated by Caroli. Caroli fails to disclose or suggest " multichannel wavelength selective filter with variable-per-channel attenuation for *blocking channels not carrying signals to be added to the network...*". This means that if a channel to be added does not carry a signal, then this channel is blocked by the wavelength selective filter. Caroli discloses wavelength blockers, but their function in the add/drop node is completely different from the function of the wavelength selective filter in the present invention. In Caroli's solution the blockers always work in pairs in one add/drop node.

Because the focus of Caroli's solution is on collision avoidance the first blocker blocks channels that were dropped so that these channels are not present in the through path. Conversely the second blocker (working on the add path) blocks the channels that have not been dropped and in consequence they will not be added to the through path (see paragraph 0028, last five lines). Wavelengths of the channels to be added are equal to the wavelengths of the dropped channels. In this way, when the add path (comprising *only* the channels to be added) is combined with the through path (comprising only the channels that have not been dropped) collision of channels is avoided. Paragraphs 0031 to 0033 indicated by the Examiner describe operation of the paired blockers 225 and 240 and this is clearly different from the operation of the wavelength selective filter in the present invention.

Caroli uses the blockers (e.g., 225 and 240) to implement wavelength reuse: what is blocked by blocker 225 is passed through blocker 240 and vice versa (see par. 0025). The solution presented by Caroli allows for remote configuration because control of the add/drop node is limited to control of the blockers (see paragraph 0030). When one of the channels is to be dropped, the blocker on the through path blocks this channel, and the blocker on the add path lets this channel through so it can be combined with other channels in the through path (through and express channels). Caroli, however, fails to disclose or suggest blocking on the add path a channel that is to be added when the channel does not carry a signal. *In Caroli's solution channels to be added are always let through the blocker on the add path.*

Although Caroli mentions "unused" optical channels, these are not the channels to be added. In paragraph 0026 is it made clear that the "unused" channels are blocked on the add path in order to avoid signal collision with signals on the through path. This means that the "unused" is

a naming convention only, which relates to channels that are not to be added to the through path because they were not dropped (their presence in the through path indicates that they have not been dropped).

Because Caroli failed to disclose a wavelength selective filter with variable-per-channel attenuation for blocking channels not carrying signals to be added to the network the applicants believe that the present invention as defined in the independent claims is novel.

The present invention is also non-obvious over Caroli when taken on its own or in any combination with other prior art. A person skilled in the art would not be motivated to use the teachings of Caroli in order to arrive at the solution as defined in the present invention because Caroli is not concerned with the problem of optical signal-to-noise ratio. Additionally, blocking (on an add path) a channel to be added results in this channel not being added to the through path and therefore cannot be regarded as a standard or obvious procedure.

The solution illustrated in Fig. 1 and described in the specification was made available to the public for the first time at the date of publication of the present patent application. In consequence, it was not known before the priority date of the present invention. Neither Caroli nor any other prior art cited by the Examiner or submitted with this amendment as an update to the IDS discloses blocking on an add path a channel that is to be added to the through path. Therefore the applicants believe that the invention as defined in the independent claims is non-obvious and in consequence all claims dependent on the independent claims are also non-obvious.

IV. In response to point 8 the applicants are of the opinion that the solution illustrated in Fig. 1 and described in the specification must not be regarded as prior art for the assessment of

obviousness. At the time the invention was made the solution illustrated in Fig. 1 and described in the specification was known only to the applicants and was not available in any way to the public. Therefore the person having ordinary skill in the art could not have this knowledge and in consequence could not use the teachings of this particular solution. Fig. 1 and its description have been discussed at an opposition proceedings before the European Patent Office in the context of admissibility as a prior art. The Opposition Division decided that Fig. 1 and accompanying description do not form prior art for this invention because they were known only to the applicant and not known to the public before publication of the present patent application. This decision is in line with an earlier decision of the Board of Appeal of the European Patent Office reported as T0654/92 (page 7, point 4.3).

It must, however, be noted that U.S. Patent Application Publication No. 2001/0040710 to Sharratt fails to disclose using a multichannel wavelength selective filter with variable-per-channel attenuation *for blocking channels not carrying signals*. Therefore, even the combination of the solution shown in Fig. 1 of the present application and the teaching of Sharratt would not result in a solution as presently claimed because there is nothing in Sharratt's disclosure or in the description of Fig. 1 in the present application that would suggest blocking channels not carrying signals on the add path.

V. The European counterpart of this application has been granted a patent, which was later opposed. In the opposition proceedings the opponent cited the prior art documents listed below, and disclosed to the U.S., Patent Office in the accompanying PTO Form-1449. Three of these documents are published in German. The U.S. counterpart of one of these exists and is enclosed. For the two other German publications, translations into English are enclosed. Although it will not

affect prosecution of the U.S. application, the opposition had been rejected in its entirety, and the European patent maintained as granted.

Prior art cited in the opposition proceedings:

U.S. Patent No. 5,917,625 A1

European Patent Application No. 0959577A2

European Patent Application No. 1065821A2

U.S. Patent No. 6,323,994 B1

European Patent Application No. 766357A1 (English translation attached)

European Patent Application No. 766358A1 (English translation attached)

European Patent Application No. 1089479A2

European Patent Application No. 242802A2

U.S. Patent No. 6,288,810 B1

U.S. Patent No. 6,285,479 B1

European Patent Application No. 1156607A2

German Patent Application No. 4326522A1

(with U.S. counterpart U.S. Patent No. 5,504,827 A1)

The Rule 17(p) fee of **$180.00** is enclosed.

Specification headings were added as required.

Petition is hereby made for a one-month extension of the period to respond to the outstanding Official Action to January 20, 2008. A check in the amount of **$120.00,** as the Petition fee, is enclosed herewith. If there are any additional charges, or any overpayment, in connection with

the filing of the amendment, the Commissioner is hereby authorized to charge any such deficiency, or credit any such overpayment, to Deposit Account No. 11-1145.

Wherefore, a favorable action is earnestly solicited.

Respectfully submitted,

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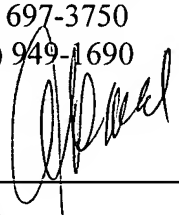

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